

REMARKS

Further and favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-26 and 28-30 are pending in this application. By this Amendment, claims 1, 6, 7, 10, 13-16, 18, 19, 24 and 25 are amended to remove the non-elected subject matter, and claims 2, 8, 17, 20-23, 28 and 29 are cancelled. No new matter is added.

I. Personal Interview

The courtesies extended to Applicants' representative by Examiner Loewe and Examiner Shameem at the interview held January 30, 2009, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

II. Claim Objections

The Examiner objects to claims 1, 2, 4-10, 12, 15 and 26 for containing non-elected subject matter. By this Amendment, the non-elected subject matter has been removed, rendering the objection moot. In addition, during the personal interview, the Examiner agreed to extend the search to encompass all of the species of elected Group I. Accordingly, prompt examination of the full scope of elected Group I is respectfully requested.

III. Claim Rejection under 35 U.S.C. § 103

The Examiner has rejected claims 1, 2, 4-10 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Filzen et al. (WO 03/084916, "Filzen"). Applicants respectfully traverse the rejection.

As agreed upon during the personal interview, the Rule 132 Declaration filed on December 4, 2008, shows that it is surprising and unexpected for the claimed compound β -1-3 (Table 166 on page 265 of the present specification), which has R^2 as a methyl group and an EC₅₀ value for PPAR δ activity of 9.9 nm, to be four times lower than the reference compound, which has R^2 as a hydrogen atom and an EC₅₀ value for PPAR δ activity of 37nm. Accordingly, it is surprising and unexpected that the claimed β -1-3 compound is four times more potent than the reference compound.

In addition, as agreed upon during the personal interview, the Rule 132 Declaration also shows that it is surprising and unexpected for the claimed compounds β -1-15, Compound 1 and Compound 2, which have CO₂Me, CH₂OMe and CH₂OEt groups at the R² position, respectively, to have an EC₅₀ value for PPAR δ activity of more than 25 times lower than that of the reference compound. Therefore, it is surprising and unexpected that a substituent at variable R² of formula (I) is needed in order to demonstrate very strong PPAR δ activity.

Thus, the compounds of formula (I) of claims 1 and 24 would not have been rendered obvious by Filzen. Claims 3-8, 5-16, 18, 19, 25, 26 and 30 depend from claims 1 or 24 and, thus, also would not have been rendered obvious by Filzen. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-7, 9-16, 18, 19, 24-26 and 30 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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February 4, 2009